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10/566,200	01/27/2006	Rainer Schenk	188.606	3667
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EXAMINER WATTS, ALAN B				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/566,200

**Applicant(s)**

SCHENK ET AL.

**Examiner**

ALAN B. WAITS

**Art Unit**

3656

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 1/27/2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 January 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date 1/26/2006
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Inventor's Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the tensioning roller, the running disk and the fixed locating pin must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitations "the first sealing lip", "the outer wall", "the inner wall", and "the clockwise direction". There is insufficient antecedent basis for these limitations in the claim.

Claim 2 recites the limitation "the inner sealing lip". There is insufficient antecedent basis for this limitation in the claim.

Claim 7 recites the limitations "the outside" and "the side". There is insufficient antecedent basis for these limitations in the claim.

Claim 8 recites the limitations "the shoulder diameter", "the diameter of the bearing ring", "the region", "the end face", and "the inside diameter". There is insufficient antecedent basis for these limitations in the claim.

Claim 9 recites the limitation "the region". There is insufficient antecedent basis for this limitation in the claim.

Claim 11 provides for the use of a rolling-contact bearing, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Regarding claim 11, the phrase "or the like" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

Claim 14 recites the limitations "the manner", "the outside", "the inside", and "the direction". There is insufficient antecedent basis for these limitations in the claim.

***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 11 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-5, 7, and 14, as best understood, are rejected under 35 U.S.C. 102(a,e) as being anticipated by Gotoh USP 6719459.

Gotoh discloses a similar device comprising:

Re clm 1:

- an elastic sealing disk (108, fig 11) running around with an outer bearing ring (5, fig 11) or a housing, having a reinforcement (109, fig 11) and positionally fixed with positive engagement in a receptacle or an annular groove (107, fig 11)
- the sealing disk engaging with a flexible seal (214, fig 11) in a recess of an inner bearing ring (3, fig 11) and being supported by means of a sealing edge on a wall (113, fig 11)
- the first sealing lip (214, fig 11) is supported axially on the outer wall of the recess and a second sealing lip (111, fig 11) is assigned to the inner wall of the recess with play
- a mass of the first sealing lip forming a center of mass, which, in a fitted position of the sealing arrangement, is offset in relation to a supporting line determined by the sealing disk (fig 11) [in such a way that the centrifugal force acting at the center of mass initiates a force component acting in the clockwise direction]

Re clm 2:

- A shoulder diameter of the inner bearing ring exceeds an inside diameter of the inner sealing lip (fig 11)

Re clm 3:

- A distance between the inner wall of the recess and a free end of the second sealing lip is designed in such a way that, even with a maximum rotational speed of the rolling-contact bearing, it ensures a distance  $(a) > 0$  (fig 11)

Re clm 4:

- The first and second sealing lips being made to extend from a common sealing lip root of the sealing disk (fig 11)

Re clm 5:

- An axial offset between an end face (110, fig 11) of the sealing disk and the sealing edge of the first sealing lip being obtained in a fitted position of the two sealing lips (fig 11)

Re clm 7:

- the first sealing lip having on the outside, on the side facing the second sealing lip, a bead (bottom of 214, fig 11)

Re clm 14:

- the reinforcement, formed in the manner of a disk, of the sealing disk being encapsulated at least on one side by an elastic sealing material (110, fig 11) of the sealing arrangement (fig 11)

- the reinforcement forming on the outside an angled-away flange (between 107 and 109, fig 11) and on the inside a leg (angled portion of 214 next to L2, fig 11) inclined obliquely in the direction of the recess

7. Claims 1, 6, and 9-10, as best understood, are rejected under 35 U.S.C. 102(a,e) as being anticipated by Gotoh USP 6719459.

Re clm 1:

- an elastic sealing disk (108, fig 10) running around with an outer bearing ring (5, fig 37) or a housing, having a reinforcement (109, fig 107) and positionally fixed with positive engagement in a receptacle or an annular groove (107, fig 10)
- the sealing disk engaging with a flexible seal in a recess (113, fig 10) of an inner bearing ring (3, fig 10) and being supported by means of a sealing edge on a wall (115, fig 37)
- the first sealing lip (above 114, fig 10) is supported axially on the outer wall of the recess and a second sealing lip (bottom right end of 111, fig 10) is assigned to the inner wall of the recess with play
- a mass of the first sealing lip forming a center of mass, which, in a fitted position of the sealing arrangement, is offset in relation to a supporting line determined by the sealing disk (fig 10) [in such a way that the centrifugal force acting at the center of mass initiates a force component acting in the clockwise direction]

Re clm 6:



- the second sealing lip, obliquely inclined in relation to the inner wall and designed as a toe wall, is arranged axially offset in relation to the first sealing lip by a distance (fig 10)

Re clm 8:

- the recess of which in the inner bearing ring has walls of different heights
- the height of the inner wall, defined by the shoulder diameter of the bearing ring, exceeding the size of the diameter of the bearing ring in the region between the recess and the end face and also the inside diameter of the second sealing lip (fig 10)

Re clm 9:

- the first sealing lip being provided with at least one venting groove in the region of the sealing edge (groove that element above 114 fits into 3, fig 10)

Re clm 10:

- the venting groove of which is made to extend in a radial or inclined manner (fig 10)

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 11-13, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Gotoh USP 6719459 as applied to claim 1 above, and further in view of Kaiser et al US 2003/0017894.

Gotoh discloses all the claimed subject matter as described above.

Re clm 11, Gotoh does indeed disclose using his bearing for supporting various rotating parts, he does not explicitly disclose:

- A rolling-contact bearing that is used in a tensioning roller or a deflecting roller of a tensioning system by which a belt or the like of a belt, chain or similar drive is pretensioned

Kaiser teaches a tensioner comprising:

- A rolling-contact bearing that is used in a tensioning roller (fig 1) or a deflecting roller of a tensioning system by which a belt or the like of a belt, chain or similar drive is pretensioned

It would have been obvious to one of ordinary skill in the art at the time of the invention to substitute Kaiser's bearing with Gotoh's bearing to achieve the predictable results of rotatably supporting the tensioner.

Re clm 12, Kaiser's tensioner further comprises:

- A running disk (2, fig 1) which encloses the rolling contact bearing [and at the same time undertakes the function of an outer peripheral bearing ring]

Re clm 13, Kaiser's tensioner further comprises:

- A rotationally fixed locating pin (9, fig 1) or carrying body for the roller-contact bearing [which at the same time includes the function of an inner, rotationally fixed bearing ring]

Regarding the functional recitation(s) in the claim(s) above denoted by the "[ ]" the examiner notes while features of an apparatus may be recited either structurally or functionally, claims directed to >an< apparatus must be distinguished from the prior art in terms of structure rather than function. The reference discloses all the claimed structural limitations and therefore anticipates the claim. See MPEP 2114. Additionally, the apparatus is capable of performing the claimed functions.

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ohata et al. USP 7416343 discloses a similar device.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALAN B. WAITS whose telephone number is (571)270-3664. The examiner can normally be reached on Monday through Friday 7:30 am to 5 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on 571-272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alan B Waits/  
Examiner, Art Unit 3656

/Richard WL Ridley/  
Supervisory Patent Examiner, Art Unit 3656